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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,330	10/24/2003	Patrick Haluptzok	13768.783.121	8251

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EXAMINER	
NGUYEN, MAIKHANH	
ART UNIT	**PAPER NUMBER**
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/693,330	HALUPTZOK ET AL.	
	Examiner	Art Unit	
	Maikhanh Nguyen	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to application filed 10/24/2003.

Claims 1-28 are presented for examination. Claims 1 and 16 are independent claims.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- The limitation "*an interface*" (claim 1, line 10) renders the claim indefinite. It is unclear if it is referring to "*an interface*" recited at line 5.
- The limitation "*an application program interface*" (claim 16, line 7) renders the claim indefinite. It is unclear if it is referring to "*an application program interface*" recited at line 2.

- The limitation "*a scope of input for a text field*" (claim 16, line 5) renders the claim indefinite. It is unclear if it is referring to "*a scope of input for a text field*" recited in the claim at lines 3-4.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 recites a system, which is interpreted as a computer program. The claim fails to assert the program stored on a computer-readable storage medium so as to be structurally and functionally interrelated to the medium and permit the function of the descriptive material to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer without a computer-readable storage medium needed to realize the computer program's functionality, it is regarded as nonstatutory functional descriptive material.

Dependent claims 2-14 are rejected for fully incorporating the deficiencies of their base claim.

Claims 15 and 28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a signal directly or

indirectly by claiming a medium and the Specification (pages 9-11) recites evidence where the computer readable medium is define as a ***"wave"*** (such as a carrier wave). In that event, the claims are directed to a form of energy which at present the office feels does not fall into a category of invention.

Claims 16-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Under a broadest reasonable interpretation, the method claim 16 is unpatentable under section 101 because (i) it does not qualify as a "process" under section 101, as that term has been interpreted by case law, (ii) it seeks to patent an abstract idea, and (iii) the "useful, concrete, and tangible result" test does not apply here, but the claim nevertheless does not meet that test. The method claim 16 differs from traditional process claims in several respects. For example, the claim does not recite any particular way of implementing the steps, nor does it require any machine or apparatus to perform the steps. In addition, the method claim does not recite any electrical, chemical, or mechanical acts or results, which are typical in traditional process claims. Finally, the claim does not call for any physical transformation of an article to a different state or thing. While claim 16 does perform a transformation of data by *for setting a scope of input for a text field of executable software code*, it does not require any machine or apparatus to perform the steps. Because the claim is completely untethered from any sort of structure or physical step, it is directed to a disembodied concept. In other words, the claim is nothing but a disembodied abstract idea until it is instantiated in some physical way so as to be

limited to a practical application of the idea. For example, claim 16 does not specify whether the entity performing the steps of *invoking, setting* and *obtaining* is a computer, a human, or something else. Accordingly, the claim is so broad that it is directed to the abstract idea itself, rather than a practical implementation of the concept. In addition, the claim is "so abstract and sweeping" that it would "wholly pre-empt" all applications (whether performed by a machine or a human) that are directed to inputting text information.

Claims which are broad enough to read on statutory subject matter or on non-statutory subject matter are considered non-statutory. Cf. In re Lintner, 458 F.2d 1013, 1015, 173 USPQ 560, 562 (CCPA 1972) ("Claims which are broad enough to read on obvious subject matter are unpatentable even though they also read on nonobvious subject matter.") During prosecution, applicant can amend to limit the claims to statutory subject matter.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-28 are rejected under 35 U.S.C. 102(b) as being anticipated by **Vale** (US 6359572, issued 03/19/2002).

As to claim 16:

Vale teaches a method for providing context information to an input method *(e.g., a graphical windowing environment 60 is generally operational to receive user input through a variety of devices ... provide a single and flexible interface for a plurality of different input methods 64; col.3, line 53-col.4, line 20)*, comprising the steps of:

- invoking an application programming interface for setting a scope of input for a text field of executable software code; setting a scope of input for a text field of the executable software code *[e.g., The uiAction parameter can include the values SIP_SETSIPINFO, SPI_GETSIPINFO, SPI_SETCURRENTIM and SPI_GETCURRENTIM. SIP_SETSIPINFO indicates that pvParam points to a SIPINFO structure (described above). The cbSize, dwImDataSize and pvImDataSize are filled in before calling the SHSipInfo function. In response to this call, the SIPINFO structure is filled in with the current SIP size, state, and visible desktop rectangle. If both dWImDataSize and pvImData are nonzero, the data size and pointer are sent to the Input Method 64. If the Input Method 64 is called but does not provide Input Method-specific data, or the format or size of the data passed in is not in a format recognized by the Input*

Method 64, then the SHSipInfo function call fails (returns zero). If the size and format are supported by the Input Method 64, the Input Method 64 fills in the buffer that is pointed to by pvImData with the Input Method-specific data. Typically, an application 29 will set the pvImDataSize to zero and pvImData to NULL. A uiAction of SPI_SETSIPINFO indicates that pvParam points to a SIPINFO structure; col.9, lines 1-27];

- invoking an application programming interface for obtaining the scope of input set for the text field of the executable software code; and obtaining the scope of input set for the text field of the executable software code *(e.g., Such a graphical windowing environment 60 is generally operational to receive user input through a variety of devices ... user input to an application having "input focus," typically in the form of a keyboard character event. Note that a number of applications 29 may be executable by the computer system, however one application that is currently running is said to have "input focus" and receive the input ... any application capable of handling keyboard input may be used with any appropriately- configured input method 64. Indeed, if an optional keyboard 36 is present, keystrokes are directly provided by a keyboard driver 62 to the graphical windowing environment 60, whereby appropriate keystrokes are likewise placed in the message queue of the active application's window without the application being provided with information as to the source; col. 3, line 53-col.4, line 20 and col.14, lines 26-52).*

As to claim 17:

Vale teaches using the scope of input obtained for recognizing input for the text field of the executable software code *[e.g., the input character value is passed to the prediction engine 76, which ordinarily returns a predicted next key based thereon. Note that the prediction engine 76 may return a message or the like indicating that it does not have enough information to predict a next key ... an input method may provide a dynamic key that is an apostrophe when the user is typing in the name field and a left parentheses (e.g., for entering an area code) when the user is in the phone number field ... the dynamic key may further change to a right parentheses after the left parentheses has been tapped while the user is in the phone number field; col. 15, line 17-line 58].*

As to claim 18:

Vale teaches passing a list of words *[e.g., the input character value is passed to the prediction engine 76, which ordinarily returns a predicted next key based thereon ... consider an application having two fields for receiving a person's name and phone number, respectively. In accordance with the present invention, an input method may provide a dynamic key that is an apostrophe when the user is typing in the name field and a left parentheses (e.g., for entering an area code) when the user is in the phone number field. Note that with the present invention, the dynamic key may further change to a right parentheses after the left parentheses has been tapped while the user is in the*

phone number field ... pass it to the application as described above; col. 15, line 18-col.16, line 9].

As to claim 19:

Vale teaches passing a list of phrases *(col.4, lines 21-54).*

As to claim 20:

Vale teaches passing a common input scope *(col.4, lines 21-43).*

As to claim 21:

Vale teaches passing an identifier for a defined format with an associated fixed list of characters *(e.g, If the size and format are supported by the Input Method 64, the Input Method 64 fills in the buffer that is pointed to by pvImData with the Input Method-specific data. Typically, an application 29 will set the pvImDataSize to zero and pvImData to NULL; col.8, line 49-col.9, line 18).*

As to claim 22:

Vale teaches passing a regular expression *(col.13, line 63-col.14, line 4).*

As to claim 23:

Toepke teaches obtaining a set of input scopes *(col.4, lines 21-43).*

As to claim 24:

Toepke teaches obtaining a list of words *(e.g., Input methods 64 ... The SIP manager 58 also provides a user interface enabling user selection from a displayable list of available input methods; col. 4, lines 21-34 and col.6, lines 49-56).*

As to claim 25:

Toepke teaches obtaining a list of phrases *(e.g., a user interface enabling user selection from a displayable list of available input methods; col. 4, lines 21-34 and col.6, lines 49-56).*

As to claim 26:

Vale teaches obtaining a common input scope *(e.g., the Input Method 64 as a parameter accompanying this Select() method call; col.10, lines 1-7 and col.12, line 44-col.13, line 62).*

As to claim 27:

Vale teaches obtaining a regular expression [*e.g., typing the expression "That's anti-climactic"; col.16, line 36-col.17, line 40].*

As to claim 28:

Vale teaches a computer-readable medium having computer-executable instructions *(e.g., computer-readable medium having computer-executable instructions; see claim 10).*

As to claim 1:

It is directed to a system for performing the method of claim 16, and is similarly rejected under the same rationale.

As to claims 2-6, 8, 9, 10, 11, and 15:

Refer to the discussion of claims 18-22, 23, 25, 24, 27, and 28 above, respectively, for rejections.

As to claim 7:

Vale teaches a parameter for passing a set of input scopes *[e.g., The GetImData() method is called when an application program 29 has asked the SIP for the SIPINFOdata structure and has provided a non-NULL pointer for the pvImData member of the SIPINFO structure. The application 29 will ordinarily cause this call to be made when requesting some special information from the Input Method 64. Two parameters are passed with this call, dwsize, the size of the buffer pointed to by pvImData, and pvImData, a void pointer to a block of data in the application 29 ... The SetImData() method is called when an application 29 has set the SIPINFO data structure and has*

provided a non-NULL pointer for the pvImData member of the SIPINFO structure. The application 29 will ordinarily cause this call to be made when requesting that the Input Method 64 set some data therein. The parameters passed with this call include dwsize, the size of the buffer pointed to by pvImData, and pvImData, a void pointer to a block of data in the application 64; col. 11, lines 38-64].

As to claim 12:

Vale teaches a recognizer for speech *(e.g., voice recognition; col.4, lines 21-25).*

As to claim 13:

Vale teaches a recognizer for handwriting *(e.g., a handwriting recognition; col.4, lines 21-25).*

As to claim 14:

Vale teaches a recognizer for an input method editor *(col. 4, line 61-col.5, line 16).*

Conclusion

5. The prior art made of record, listed on PTO 892 provided to Applicant is considered to have relevancy to the claimed invention. Applicant should review each identified reference carefully before responding to this office action to properly advance the case in light of the prior art.

Contact information

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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